

REMARKS

Claims 1-8 stand rejected under *35 U.S.C. §102(e)* over U. S. Patent Publication No. 2003/0220876 to Burger (“Burger”).

According to *MPEP §2131*, “to anticipate a claim, the reference must teach every element of the claim.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Under *U.S.C. §103*, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1733 (Sup. Ct. 2007) (quoting *In re Graham v. John Deere Co of Kansas City*, 86 S. Ct. 684 (Sup. Ct. 1966)). Accordingly, an essential step in determining whether an invention is obvious is consideration of the elements being claimed. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970), cited in *MPEP §2143.03*.

Regarding claim 8, claim 8 recites in combination with numerous additional elements, the element of “wherein, responsive to an indication that said processor module is not configured to perform said decoding correctly, said communication module is configured to request from said remote computer-based apparatus at least one machine-readable instruction for properly configuring said processor module to decode said data.”

The statement of rejection of the Examiner as to the highlighted claim elements is as follows:

wherein, responsive to an indication that said processor module is not configured to perform said decoding correctly, said communication module is configured to request from said remote computer-based apparatus at least one machine-readable instruction for properly configuring said processor module to decode said data (see [0098], via a network that controls access to stored information and that also provides service to Pocket Vault holders). *March 13, 2009 Office action, page 5.*

The relied on section of Burger referenced in the statement of rejection is as follows:

As shown in FIG. 1, the network server 114 may form the hub of the network system 100, with each of the interface stations 104, the commercial card readers 106, the commercial bar code readers 107, the RFID interrogators 116, and the computers 108, 110, and 112 being coupled thereto. As discussed in more detail below, the network server 114 may therefore serve as: (1) a repository of information for the network, (2) the entity that controls access to the stored information by the other network devices, and (3) a service provider for financial and non-financial media issuers, advertisers, as well as Pocket Vault holders. *U. S. Patent Publication No. 2003/0220876, paragraph [0098].*

Applicants have reviewed both the statement of rejection and the relied on teaching at paragraph [0098] and respectfully state that applicants can find no reference or suggestion of the highlighted elements in the specific context as recited in claim 8 either in the statement of rejection or in the reference itself. If the Examiner wishes to maintain the rejection of claim 8, the Examiner is respectfully requested to indicate where in the relied on reference there is a teaching or suggestion of “wherein, responsive to an indication that said processor module is not configured to perform said decoding correctly, said communication module is configured to request from said remote computer-based apparatus at least one machine-readable instruction for properly configuring said processor module to decode said data” in the specific context as recited in claim 8.

During a telephone interview of June 15, 2009 (a Communication to Record Substance of Interview is attached and incorporated herein by reference) the applicants through their representative requested the Examiner to identify where in Burger in the relied on section at paragraph [0098] there is a teaching or suggestion of “wherein, responsive to an indication that said processor module is not configured to perform said decoding correctly, said communication module is configured to request from said remote computer-based apparatus at least one machine-readable instruction for properly configuring said processor module to decode said data.”

The Examiner declined to attempt to substantively identify the noted elements in Burger during the telephone interview.

The Examiner did state however, that the Examiner would identify the noted elements in a further communication to the applicants after a Request for Reconsideration After Final Action is filed by the applicants.

The Examiner therefore is respectfully requested to explain where in the Burger there is a teaching or suggestion of “wherein, responsive to an indication that said processor module is not configured to perform said decoding correctly, said communication module is configured to request from said remote computer-based apparatus at least one machine-readable instruction for properly configuring said processor module to decode said data” as set forth in the context of the specific recitation of claim 8.

During the telephone interview of June 15, 2009, the Examiner indicated that the Examiner does not normally grant interviews after Final rejection. After further reviewing provisions of the Manual of Patent Examining Procedure ('MPEP') applicants respectfully highlight that the MPEP specifically authorizes Examiners to grant interviews after Final. The MPEP specifically sanctions interviews after Final: “Normally, one interview after final rejection is permitted...” See *MPEP §713.09*.

In view of the MPEP sanctioning interviews after final as a means of expeditiously advancing prosecution, applicants' request of the Examiner to identify in Burger the highlighted elements of claim 8 in the context as recited in claim 8 is emphasized.

Regarding claim 1, claim 1 recites in combination with numerous additional elements the elements of “a radio frequency reader, said reader configured to read a radio frequency payment token presented as a payment medium for said *ad libitum* financial transaction, said radio frequency reader devoid of a capability to simulate a reader employing reader technology other than radio frequency.”

As applicants understand, the statement of rejection as to the highlighted element of claim 1 is as follows:

Applicants argue that Burger does not disclose “radio frequency reading [being] devoid of a capability to simulate a reader employing reader technology other than radio frequency.” The Examiner respectfully disagrees. Burger disclosed in paragraph 41 a portable substrate; a power supply supported by the substrate; and at least one controller supported by the substrate and powered by the power supply, the at least one controller being configured to generate a simulated magnetic stripe on the substrate other than radio frequency. *March 13, 2009 Office action, page 6.*

The section of the relied on reference relied on by the Examiner is as follows:

According to another aspect, an apparatus includes: a portable substrate; a power supply supported by the substrate; and at least one controller supported by the substrate and powered by the power supply, the at least one controller being configured to generate a simulated magnetic stripe on the substrate. *U. S. Patent Publication No. 2003/0220876, paragraph [0041].*

The feature described in paragraph 41 of Burger is further described at paragraph [0149] of Burger in connection with Fig. 6 of Burger.

FIG. 6 is a block diagram showing an example embodiment of the token 102a shown in FIGS. 1 and 2. As shown, the token 102 may be equipped with a controller 602. In the embodiment shown, the controller 602 may be selectively programmed, for example, via interface terminals 606 to generate a current in a wire loop 608 so as to generate a magnetic field about the wire loop 608 that simulates a magnetic stripe of a standard credit card-like token. In other words, a magnetic field may be generated along the edge of the token 102a as if a magnetic stripe were present on that edge. The location of the simulated magnetic stripe on the token 102a is identified in FIG. 6 as a virtual magnetic stripe 610. *U. S. Patent Publication No. 2003/0220876, paragraph [0149].*

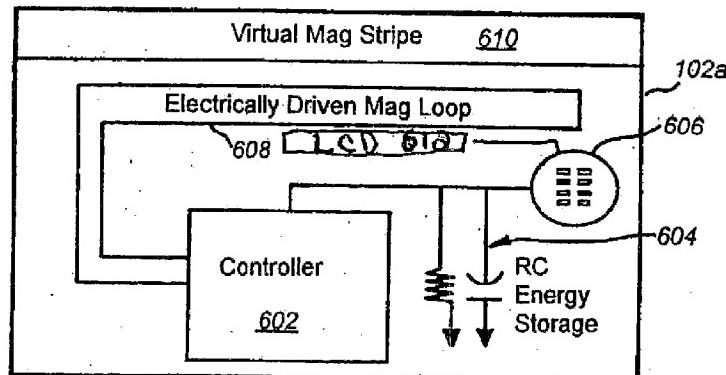


Fig. 6

Regarding the rejection of claim 1 over Burger, applicants can find no teaching or suggestion in either the statement of rejection or in the relied on reference. Regarding claim 1, claim 1 recites in combination with numerous additional elements the elements of “a radio frequency reader, said reader

configured to read a radio frequency payment token presented as a payment medium for said *ad libitum* financial transaction, said radio frequency reader devoid of a capability to simulate a reader employing reader technology other than radio frequency.”

First, referring to Fig. 6 of Burger, whereas a highlighted element recites reading capability, the device of Fig. 6 of Burger, as best discerned by applicants, is not described as having reading capability as required by claim 1, but rather is described as being a token of the type subject to reading by a reader. If the Examiner wishes to maintain the rejection of claim 1, the Examiner is respectfully requested to explain where in Burger the payment token of Fig. 6 of Burger is described as including reading capability.

Further, it appears with reference to the rejection of claim 1 that the Examiner may have misread the elements of claim 1. Whereas claim 1 requires a radio frequency “**devoid** of a capability to simulate...,” the Examiner has pointed to no suggestion or teaching of Burger relating to the feature of being “devoid of a capability to simulate.” Rather, the Examiner has pointed to elements relating to a positive incorporation of a simulation feature. If the Examiner wishes to maintain the rejection of claim 1, the Examiner is respectfully requested to explain where in Burger there is a teaching or suggestion related to “a radio frequency reader, said reader configured to read a radio frequency payment token presented as a payment medium for said *ad libitum* financial transaction, said radio frequency reader devoid of a capability to simulate a reader employing reader technology other than radio frequency” in the specific combination as recited in claim 1.

According to *MPEP §2131*, “to anticipate a claim, the reference must teach every element of the claim.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Under *U.S.C. §103*, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be

ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1733 (Sup. Ct. 2007) (quoting *In re Graham v. John Deere Co of Kansas City*, 86 S. Ct. 684 (Sup. Ct. 1966)). Accordingly, an essential step in determining whether an invention is obvious is consideration of the elements being claimed. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970), cited in MPEP §2143.03.

While the applicants herein may have highlighted a particular claim element of a claim for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, the applicants highlighting of a particular claim element for such limited purpose should not be taken to indicate that the applicants have asserted the argument of patentability that a particular claim element constitutes the sole basis for patentability out of the context of additional combinations of elements of the claim or claims in which it is present.

Regarding the claims discussed herein, the applicants' selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. Applicants expressly reserve the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

It is believed that all of the pending claims have been addressed. However, failure to address a specific rejection, issue, or comment in the present file history does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made in the present file history are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in the present file history should be construed as an intent to concede any issue with regard to any

claim, except as specifically stated, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No amendment presented herein contains new matter.

Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: June 15, 2009

Respectfully submitted,

GSB/bs/sp

Electronic signature: /George S. Blasiak/
George S. Blasiak
Registration No.: 37,283
Customer No.: 00128